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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/539,034 | 06/11/2005 | Klaus Brychcy | 2002DE144 | 6000 |

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

GREEN, ANTHONY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1755

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/539,034

Applicant(s)

BRYCHCY ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>03/24/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Preliminary Amendment

1. The preliminary amendment has been entered. Currently claims 1-14 are pending.

Specification

2. The abstract of the disclosure is objected to because it is not found on a single page free of extraneous information. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of a specific copper phthalocyaninesulfonic acid or copper phthalocyaninesulfonic salt pigment dispersant, does not reasonably provide enablement for the use of any copper phthalocyanine-sulfonic acid or copper phthalocyaninesulfonic salt pigment dispersant. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The claims recite a copper phthalocyanine pigment preparation comprising a copper phthalocyanine pigment in combination with a copper phthalocyaninesulfonic acid or salt dispersant wherein said preparation possesses specific properties. The instant claims encompass many different pigment dispersants including those not contemplated by the disclosure as the disclosure only recites specific dispersants. Such a limited disclosure does not support the breadth of the instant claims as applicant has not shown that the use of every copper phthalocyaninesulfonic acid or salt dispersant known to man will produce a preparation having the instant properties. It is believed that one of ordinary skill in the art would be unable to produce the instant invention without undue experimentation since the types of dispersants utilized to produce a preparation having the recited properties are not recited in the claims.

5. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant has not defined what the following standards are: "ISO 14 446 standard 27A and 30A" and "DIN 53235".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrases "the 1/3 standard color depth" and "the corresponding hue" lack proper antecedent basis. It is unclear as to what is meant by the following: "ISO 14 446, standard 27A and 30A" and "DIN 53235". It is unclear as to what is meant by the phrase "the corresponding hue".

In claim 8 the phrase "the elevated temperature" is vague and indefinite as "elevated" is a relative term. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The phrase "in the presence of" is vague and indefinite.

In claim 9 the phrase "high molecular weight" is vague and indefinite as the term "high" is a relative term. The phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 10 the phrase "high molecular weight" is vague and indefinite as the term "high" is a relative term. The phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Objections

8. Claims 7 and 12 are objected to because of the following informalities: The term "dispersent" should be -- dispersant --. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 27 20 464.

The reference discloses a method in which a phthalocyanine pigment is subjected to a solvent treatment in the presence of a phthalocyanine-sulfonic salt.

The instant claims appear to be met by the reference. It is the position of the examiner that the properties of the pigment preparation are inherent absent evidence showing otherwise.

11. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 761 770.

The reference teaches a composition comprising copper phthalocyanine containing 0-4 chlorine atoms and a phthalocyaninesulfonic salt.

The instant claims appear to be met by the reference. It is the position of the examiner that the properties of the pigment preparation are inherent absent evidence showing otherwise.

12. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 780 446.

The reference teaches, in example 2, a composition comprising copper phthalocyanine and a dodecyl amine salt of copper phthalocyanine mono sulphonic acid.

The instant claims appear to be met by the reference. It is the position of the examiner that the properties of the pigment preparation are inherent absent evidence showing otherwise.

13. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Barraclough et al (US Patent No. 4,313,766).

The reference teaches, in the abstract, and the claims, a pigment composition comprising copper phthalocyanine, a solvent and a copper phthalocyanine additive.

The instant claims appear to be met by the reference. It is the position of the examiner that the properties of the pigment preparation are inherent absent evidence showing otherwise.

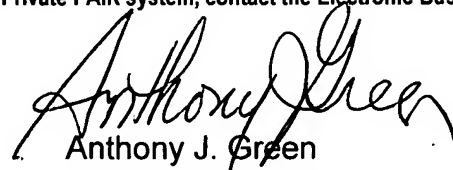
Information Disclosure Statement

14. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less relevant than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 10, 2006